

REMARKS

In response to the Office Action of January 27, 2005, Applicant respectfully requests reconsideration. Claims 1-27 were previously pending in this application. Claims 1, 16, and 22 are amended herein and claims 37-39 are newly added. As a result, claims 1-27 and 37-39 are currently pending and the application as presented is believed to be in condition for allowance.

Improper Reliance On Blumenau Under §103

Initially, Applicant notes that in the Response to Arguments section on page 12, the Office Action asserts that, “although applicant states that the present application and the Blumenau reference ‘are’ commonly assigned, no statement is made as to the **assignment status at the time the invention was made** in accordance with the rules of 103(c) [emphasis in original].” This is incorrect. Applicant filed a Response To Advisory Action And Statement Establishing Common Ownership on August 5, 2004, which stated, “Applicants hereby represent that the present application and the Blumenau reference were, at the time the invention was made, both owned by, or subject to an obligation of assignment, to EMC Corporation.” MPEP §706.02(1)(2) states that such a statement alone is sufficient evidence to establish common ownership. *See* MPEP §706.02(1)(2) page 700-55 of 8th Edition, Rev. 2, May 2004.

The Office Action asserts that questions arise as to ownership at the time of the invention because the assignment was recorded five months after filing. While Applicant appreciates that the MPEP allows the Examiner, in rare instances, to require objective evidence when the Examiner has independent evidence that raises material doubt as to the accuracy of Applicant’s representation, it is respectfully asserted that the Examiner has no such evidence in this case. The execution and recordation of the assignment after the filing date of the application is not evidence that casts doubt on Applicant’s representation that the present application was subject to an obligation of assignment to EMC Corporation at the time of the invention.

It is believed that an appreciation of the reason for the “delay” in recording the assignment will alleviate any concern the Examiner may have about the delay being unusual or raising a cloud as to ownership at the time the invention was made. This is an application that was filed without formal papers (i.e., an inventor’s declaration and assignment). It is not

uncommon for an application to be filed without an inventor's declaration and the PTO rules obviously provide for it. It is also not uncommon for the assignment document for the application to be signed by the inventor at the same time as the declaration. That is what happened here. A Notice To File Missing Parts in connection with this application was mailed on September 22, 2000 and the Applicant was given two months from the date of the Notice to file the required oath or declaration without the payment of any extension fees. Applicant did just that, filing the declaration on November 22, while recording the assignment on the same day. This providing of the formal papers within a time period that did not even require an extension from the PTO for providing an inventor's oath or declaration demonstrates that there was no unusual or particularly lengthy delay in obtaining the inventor's signature on the assignment document in connection with this application. In view of this, it is respectfully pointed out that the Examiner should not place an undue burden on Applicant to substantiate the representation already made on the record as to common ownership.

In view of the foregoing, Applicant respectfully requests that the rejection of claims 6, 8, and 10 under 35 U.S.C. §103(a), based at least in part on the commonly assigned Blumenau reference, be withdrawn.

Rejections Under 35 U.S.C. §102

Applicant notes that the Office Action maintains the rejection of claims 1-5, 7, 9, and 11-27 under 35 U.S.C. §102, as purportedly being unpatentable over Fisher (6,247,096), while conceding several times that Fisher, "fail[s] to specifically disclose the logical volume having multiple users simultaneously." See ¶27 on page 7, ¶30 on page 8, and ¶33 on page 8. While the rejected claims do not require multiple users "simultaneously," Applicant assumes that the §102 rejection was inadvertently carried over into this Office Action from the previous Office Action, because Fisher does not teach multiple owners. Accordingly, Applicant respectfully requests that the rejection of claims 1-5, 7, 9, and 11-27 under 35 U.S.C. §102 be withdrawn.

Rejections Under 35 U.S.C. §103

The Office Action gave three separate obviousness rejections to each of independent claims 1, 16, and 22. Specifically, these claims were rejected under 35 U.S.C. §103(a) as purportedly being obvious over Fisher in combination with DiChiara (4,858,117), Fisher in combination with Hart (5,285,528), and Fisher in combination with Duso (5,892,915). Each of these rejections is respectfully traversed.

The Office Action concedes that Fisher does not disclose a logical volume having multiple users, but asserts that each of the references used in combination with Fisher (i.e., DiChiara, Hart, and Duso) discloses or suggests that a logical volume may have multiple users.

While the Office Action is not explicit about what it is believed that the nature of the system is that one skilled in the art would be led to based on the combined teachings of Fisher with each of the aforementioned references, it appears to suggest that the system of Fisher would be modified to, instead of maintaining information about only a single owner of a logical volume, have a list of multiple users of the logical volume (hereinafter referred to as “the modified Fisher system”). Without conceding that one of ordinary skill in the art would have been motivated by the secondary references to modify Fisher in any way, it is respectfully asserted that each of claims 1, 16, and 22, as amended, patentably distinguishes over such a modified Fisher system.

Applicant has amended each of independent claims 1, 16, and 22 to clarify that at least a portion of the identifying information that is maintained for users of a logical volume is used in verifying that a logical volume is still in use. Support for this amendment is found in Applicant’s specification at page 35, lines 8-21. As described therein, in one embodiment, an entity performing an inventory can maintain information identifying the users of the logical volume. and this information can be used to verify that a logical volume is still in use. For example, the information identifying users of the logical volume may be used to determine which host computer or computers to query to determine whether they are still using the logical volume. Thus, for example, if it is desired to delete the contents of a logical volume to reuse the storage space occupied thereby, the entity may verify that the data in the logical volume is no longer needed by looking to the information identifying past users of the logical volume and using that

information to query these users (e.g., the host computers) to determine if any are still using the volume. If the data is no longer needed by any user, the data may be deleted. If the data is needed by one or more of the users, the data may not be deleted.

The foregoing description of one particular embodiment is provided merely to assist the Examiner in appreciating various aspects of the present invention. The description above may not apply to each of the independent claims, and the language of the independent claims may differ in material respects from the example provided. The Examiner is requested to give careful consideration to the language of each of the independent claims and to address each on its own merits, without relying on the example described above. Applicants do not rely on the foregoing to distinguish any of the claims of the present invention over the prior art, and rely solely on the arguments below.

The modified Fisher system does not use the list of users of a logical volume to verify that the logical volume is still in use. While the modified Fisher system may include identifying information for users of the logical volume, Fisher discloses an entirely different method of verifying that a logical volume is in use that does not involve use of this information. Specifically, Fisher discloses that a database table, which indicates whether each volume is mounted or not, is used to determine whether a logical volume is still in use. *See* Fisher, Figure 5 and Col. 7, lines 12-21. That is, if a volume is mounted the modified Fisher system assumes the volume is still in use. If the volume is not mounted, the Fisher system assumes the volume is no longer in use. Thus, the modified Fisher system maintains separate information (that does not identify users) to determine whether a volume is still in use.

Because the modified Fisher system does not use identifying information for users of a logical volume to verify that a logical volume is still in use, independent claims 1, 16, and 22 patentably distinguish over any combination of Fisher, with DiChiara, Hart, or Duso. Accordingly, it is respectfully requested that the rejection of claims 1, 16, and 22 under 35 U.S.C. §103(a) be withdrawn.

Each of claims 2-15, 17-21, and 23-27 depends from one of the aforementioned independent claims, and is patentable for at least the same reasons. Accordingly, it is respectfully requested that the rejections of these claims be withdrawn.

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New Claims

Claims 37-39 are newly added in this application. Each of these claims depends from one of independent claims 1, 16, and 22 and is patentable for at least the same reasons.


CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below to discuss any outstanding issues relating to the allowability of the application.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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